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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,587	10/17/2001	Nayan H. Joshi	ATOTP01000US	7222

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04/16/2003

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EXAMINER

BARR, MICHAEL E

ART UNIT	PAPER NUMBER
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1762

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DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,587

Applicant(s)

JOSHI, NAYAN H.

Examiner

Michael Barr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 04/02/2003, have been fully considered and reviewed by the examiner. Claims 1-25 are pending.

The applicant has argued against the Stevenson reference as the applicant has distinguished the claimed silver salt bath as not being an acid bath, as indicated in the specification. While the applicant can describe an acid bath as being a pH less than 5, convention defines an acid bath as having a pH less than 7. Since the claims indicate a pH range of 5-10, and preferably 6-9, a prior art acid bath having a pH between 5-7 would meet the claimed limitations. The applicant further argues that it would have been expected that the silver salt activation bath of Stevenson would be outside the claimed pH range, since the "Shipley" sensitizing bath used in Stevenson would have pH well below the claimed pH range. The examiner is not persuaded by the applicant's argument. While there is evidence that the "Shipley" sensitizer used in the Stevenson reference would probably have a pH lower than the claimed pH, this does not provide any indication or guidance as to what is the preferred pH for the silver nitrate activation bath of Stevenson, nor does it limit the pH of said silver nitrate bath. A low pH sensitizer does not dictate that the activator must be the same magnitude of pH. The materials and teachings of Stevenson offer nothing to the pH of the silver nitrate bath other than that it is acidic (i.e. pH less than 7). Therefore, it remains the position of the examiner that it would have been an obvious modification to one skilled in the art to use an acid bath of silver

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nitrate having a conventionally use pH in Stevenson. Such a conventional silver nitrate activation solution is presented by the applied Izaki reference.

The applicant argues against the Stevenson/Izaki combination indicating that there is no motivation to combine, as the Izaki reference requires a second activator with palladium ions. The examiner is not persuaded by the applicant's arguments. The examiner is merely relying on the Izaki reference to show the conventionality of using a silver nitrate bath that is acidic, aqueous, and having a pH in the claimed range for the activation of a plastic substrate for electroless deposition. One of ordinary skill in the art performing the Stevenson process would have been motivated to review the prior art to determine a usable pH for the acidic silver nitrate bath, as Stevenson does not provide a suitable pH for the silver nitrate bath. It would have been obvious to one skilled in the art, after review of the Izaki reference, to use an aqueous acid bath of silver nitrate having the claimed pH, in Stevenson, with the expectation of providing the desired activation, since such silver nitrate bath conditions are shown to be useful by Izaki for the activation of plastic substrates for electroless deposition.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson in view of Izaki et al.

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Stevenson and Izaki et al. are applied here for the same reasons as given above and in paragraph 4 of the previous office action.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson and Izaki et al. as applied to claim 5 above, and further in view of Pendleton.

Stevenson, Izaki et al., and Pendleton are applied here for the same reasons as given above and in paragraph 5 of the previous office action.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson and Izaki et al. as applied to claim 5 above, and further in view of Stamp et al.

Stevenson, Izaki et al., and Stamp et al. are applied here for the same reasons as given above and in paragraph 6 of the previous office action.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 or 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Michael Barr
Primary Examiner
Art Unit 1762

MB
April 15, 2003